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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CONRAD K. MEYER

Appeal 2008-004236
Application 10/047,629
Technology Center 2400

Decided: September 28, 2009

Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-29, which are all of the claims before us on appeal (See note 1, *infra*). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm in part.

STATEMENT OF THE CASE

Invention

Appellant's invention relates to accessing content at a resource associated with a particular Resource Locator (RL). More particularly, the invention on appeal relates to a system for searching valid RLs to locate a RL associated with a resource of interest. (Spec. 1, ll. 5-8).

Claim 1 is illustrative:

1. A method of accessing a resource associated with a resource locator (RL) comprising the steps of:
 - receiving input of a RL, said RL corresponds to a resource;
 - soliciting input of search terms if said RL is invalid;
 - receiving input of said search terms;
 - searching a predetermined index of addresses of valid RLs in accordance with said search terms;
 - presenting a list of all valid RLs in said predetermined index with addresses that correspond to said search terms;
 - receiving selection of a RL from said list; and
 - retrieving and displaying content from said selected RL.

Prior Art

The Examiner relies on the following references as evidence:

Belfiore	US 6,009,459	Dec. 28, 1999
Ling	US 2002/0059192	May 16, 2002

The Examiner's Rejections

- I. The Examiner rejected claims 1-3 and 7-22, and 24-28¹ under 35 U.S.C. § 102(e) as anticipated by Belfiore.
- II. The Examiner rejected claims 4-6, 23, and 29 under 35 U.S.C. § 103(a) as unpatentable over the combination of Belfiore and Ling.

¹ We note that in the Answer the Examiner withdrew the rejection of claims 24-28 under 35 U.S.C. § 102, and added a new ground of rejection for claims 24-28 under 35 U.S.C. 103(a). (*See* Ans. 3 and Final Office Action mailed 6/21/06, pp. 2 and 4). We do not accept the Examiner's explanation that the shift from a § 102 rejection in the Final Rejection to a § 103 rejection in the Answer was the result of a typographical error. (Ans. 3). We find the new ground of rejection was not approved by a TC Director as required by MPEP § 1207.03(I) ("Any new ground of rejection made by an examiner in an answer must be: (A) approved by a Technology Center (TC) Director or designee."). Thus, the Examiner's improper new ground of rejection under § 103 for claims 24-28 is not before us on appeal. Instead, we consider the Examiner's previous § 102 rejection of claims 24-28 as being before us on appeal. However, we summarily reverse the Examiner's § 102 rejection of claims 24-28, because this rejection is admitted to be an error by the Examiner (Ans. 3).

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Briefs and the Answer for their respective details.

Claim Groupings

Based on Appellant's arguments in the Appeal Brief, we will decide the appeal on the basis of claims 1, 4, 8, and 13. *See* 37 C.F.R. § 41.37(c)(1)(vii).

FINDINGS OF FACT

In our analysis *infra*, we rely on the following findings of fact (FF):

1. Belfiore discloses that a user enters text in the Address box. The web browser then processes the text entered by the user to determine if an "Auto-search" needs to be initiated because the text is not a valid URL. (Col. 5, ll. 13-17 and Fig. 4).
2. Belfiore discloses that during auto-search, processed text (that is entered into the address box) will be passed to a search engine to locate web pages that correspond to the text entered by the user. (Col. 5, l. 66 – Col. 6, l. 1).

APPELLANT'S CONTENTIONS

1. Appellant contends that Belfiore fails to disclose the limitation of soliciting input of search terms if said RL is invalid. (App. Br. 8; *see also* claims 1 and 8).
2. Appellant contends that Belfiore fails to disclose the limitation of searching a predetermined index of valid RLs in accordance with said RL

search string to determine valid RLs that meet the criteria of said RL search string, wherein said RL search term describes a name of a location for a desired resource and said valid RLs have names that correspond to said RL search string. (App. Br. 14; *see also* independent claim 13 and the commensuration language recited in independent claim 18).

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Has Appellant shown the Examiner erred in determining that Belfiore discloses the limitation of “soliciting input of search terms if said RL is invalid” as recited in independent claim 1, and recited in commensurate form in independent claim 8 (“soliciting input of a RL search string if said RL is invalid.”)?
2. Has Appellant shown the Examiner erred in determining that Belfiore discloses the limitation of “searching a predetermined index of valid RLs in accordance with said RL search string to determine valid RLs that meet the criteria of said RL search string, wherein said RL search term describes a name of a location for a desired resource and said valid RLs have names that correspond to said RL search string?” (Claim 13; *see also* commensurate language recited in independent claim 18).

PRINCIPLES OF LAW

Anticipation

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. However, this is not an “ipsissimis verbis” test. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellant’s Briefs to show error in the Examiner’s proffered prima facie case.

ANALYSIS

§ 102 rejection of claims 1-3 and 7-12

We decide the question of whether Appellant has shown the Examiner erred in determining that Belfiore discloses the limitation of “soliciting input of search terms if said RL is invalid,” as recited in independent claim 1 and recited in commensurate form in independent claim 8 (“soliciting input of a RL search string if said RL is invalid.”).

The Examiner proffers that a user *may* choose to enter search terms into the same address box in a subsequent attempt to invoke auto-search. (Ans. 4). Thus, according to the Examiner, the user is “implicitly” solicited to pursue auto-search mode. (Ans. 8; *see* second sentence from bottom of page).

We broadly but reasonably construe the term “solicit” in accordance with its ordinary and customary usage. Thus, in accordance with this plain

meaning, there must be some invitation, urging or incentive that prompts for *input of search terms* if the RL is invalid.

Applying this construction, we find that Belfiore does not disclose a “*solicitation*” to enter search terms if a RL is determined to be invalid, as required by the language of the claim. Belfiore discloses that the auto-search is invoked by the terms entered into the address box. (FF 1). However, we find that invoking the auto-search is not solicited after the determination of an invalid RL.

Moreover, we find the Examiner’s reliance upon what Belfiore “implicitly” teaches (i.e., suggests) is improper in the context of anticipation. (Ans. 8; *see* second sentence from bottom of page). To the extent that the Examiner may be relying upon an inherency argument, we note that “[i]nherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, (Fed. Cir. 1999)

Therefore, we agree with Appellant that the Examiner has erred regarding the anticipation rejection of independent claims 1 and 8. Accordingly, we reverse the Examiner’s § 102 rejection of independent claims 1 and 8, as well as the § 102 rejection of associated dependent claims 2, 3, 7, and 9-12.

§ 102 rejection of Claims 13-22

We decide the question of whether the Appellant has shown the Examiner erred in determining that Belfiore discloses searching a predetermined index of valid RLs in accordance with said RL search string

to determine valid RLs that meet the criteria of said RL search string, wherein said RL search term describes a name of a location for a desired resource and said valid RLs have names that correspond to said RL search string. (*See* App. Br. 11 and representative claim 13).

Based upon our review of the evidence, we agree with and adopt the Examiner's findings with respect to the aforementioned limitation. (FF 2 and Ans. 9-10). In particular, we note that Appellant has not disputed the Examiner's finding that searching a predetermined list of valid RLs is *inherent* to Belfiore's system because the indexing method is inherited from the engines that Belfiore's system uses. (Ans. 10). Further, we do not find Appellant's arguments regarding Figs 10A-11B of Belfiore (Reply Br. 4) to be persuasive in rebutting the Examiner's findings because the language of claim 13 does not require the index of RLs to be displayed.

Therefore, we find Appellant has not shown error in the Examiner's § 102 rejection of representative claim 13. Accordingly, we sustain the Examiner's rejection of representative claim 13 and claims 14-22 that fall therewith.

§ 103 Rejection of Claims 4-6, 23 and 29

Appellant argues that claims 4-6, 23 and 29 are allowable based on their dependence from claims 1, 18, and 24. Regarding claims 4-6, we do not find, nor has the Examiner established, that Ling cures the deficiencies of Belfiore. Accordingly, the rejection of claims 4-6 is reversed for the same reasons discussed *supra* regarding claim 1.

Regarding claim 23, we find that Appellant has not presented separate arguments regarding the patentability of claim 23. Accordingly, we *pro forma* sustain the Examiner's rejection of claim 23.

Because claim 29 depends from independent claim 24 that we have reversed, we also reverse the Examiner's § 103 rejection of claim 29. See Note 1 *supra*.

CONCLUSIONS

Appellant has shown the Examiner erred in determining that Belfiore discloses the limitation of "soliciting input of search terms if said RL is invalid," as recited in independent claim 1, and recited in commensurate form in independent claim 8.

Appellant has not shown the Examiner erred in determining that Belfiore discloses the limitation of "searching a predetermined index of valid RLs in accordance with said RL search string to determine valid RLs that meet the criteria of said RL search string, wherein said RL search term describes a name of a location for a desired resource and said valid RLs have names that correspond to said RL search string." (Representative Claim 13).

Regarding claims 24-28, see Note 1 *supra*.

DECISION

We reverse the Examiner's rejection of claims 1-3, 7-12, and 24-28 under 35 U.S.C. § 102(e).

We affirm the Examiner's rejection of claims 13-22 under 35 U.S.C. §102(e).

We reverse the Examiner's rejections of claims 4-6 and 29 under 35 U.S.C. § 103(a).

We affirm the Examiner's rejection of claim 23 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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